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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,667	03/12/2001	Jeffrey K. Dellinger	37168/82320	1994

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Barnes & Thornburg  
600 One Summit Square  
Fort Wayne, IN 46802

EXAMINER

GREIMEL, JOCELYN

ART UNIT PAPER NUMBER

3624

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/804,667	<b>Applicant(s)</b> DELLINGER ET AL.	
	<b>Examiner</b> Jocelyn W. Greimel	<b>Art Unit</b> 3624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03/12/01.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/22/01, 10/13/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to the Applicant's application filed March 12, 2001 and Applicant's amendment filed September 15, 2005. In view of Applicant's amendment, the election to one of the following inventions is deemed necessary. The restrictions cited are as stated below:

#### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - a. Group 1: Claims 1-16 are drawn to a method for administering a benefit plan having a feature that provides a stream of systematic withdrawal payments during a liquidity period and a subsequent stream of annuity payments when the systematic withdrawal payments cease.
  - b. Group 2: Claims 17-36 are drawn to a method of administering an annuity product having a withdrawal feature, a maximum withdrawal rate and a guarantee.
3. The inventions are distinct, each from the other because of the following reasons:
  - a. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for

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patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

b. In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because, Group I, the invention does not rely upon a withdrawal feature, a maximum withdrawal rate and a guarantee. The subcombination has separate utility such as providing a method of administering an annuity product having a withdrawal feature, a maximum withdrawal rate and a guarantee.

c. The independent claims in each Group I and II recite limitations that are not found together in a common independent claim of the other group, thus it is evidence that Applicant believes a distinct invention combination lies within each set of independent claims. Also, the dependent claims then append a multiple of distinct inventive concepts for which Applicant's submission is evidence that Applicant believes each supports a distinct reason for invention. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different concepts, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of one of the inventions I and II to be examined even though the requirement be traversed (37 C.F.R. §1.143).

5. A telephone call was made to Mr. Bobby Gillenwater (Reg. No. 31,105) on March 13, 2006, to request an oral election to the above restriction requirement. Mr. Gillenwater elected Group II (Claims 17-36) with traverse.

6. Applicant is respectfully advised to cancel all the non-elected claims. Additionally, Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 17-36 are rejected under 35 U.S.C. 102(b) as being unpatentable over Golden (US Patent 5,933,815). With regard to claim 17, Golden discloses a computerized method for administering an annuity product having a withdrawal feature and a guarantee (col. 2, lines 24-28) comprising the steps of: (a) establishing an annuity account from which withdrawals can be made (col. 2, lines 41-49), (b) inputting data relating to the annuity account, including data relating to at least one account owner, an

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account value and a maximum withdrawal rate for a given withdrawal frequency (col. 8, lines 29-57), (c) paying withdrawals to the account owner and deducting amounts of the withdrawals from the account value (col. 12, lines 47-66) and (d) providing a guarantee that said withdrawals will continue to be paid for a specified time period, provided that the rate of said withdrawals does not exceed the maximum withdrawal rate, even if the account value is exhausted before the end of the specified time period (col. 2, lines 62-67 – col. 3, lines 1-2 and col. 3, lines 39-62).

9. Golden provides a method of guaranteed payments (withdrawals) for a specified period of time. The method of Golden does not use the term “maximum withdrawal rate” in such that the guaranteed payments will continue as long as the withdrawals fall below this maximum withdrawal rate. Golden does provide this instrumentality with the “ability to make partial withdrawals from the client account and retain an adjusted continuous guaranteed lifetime income.” The “partial” withdrawals of Golden could be viewed as any withdrawal which would fall under the maximum withdrawal rate.

10. With regard to claims 18,19, 20, 26, 27, 28 and 29, Golden discloses guaranteed payments during certain time periods including business choices such as: the time period for guaranteed payments to be the lifetime of the owner (col. 2, lines 15-21); the time period is a period independent of the owner’s lifetime (a beneficiary lifetime) (col. 7, lines 62-67 – col. 8, lines 1-3); the time period is a period during which withdrawals at least equal one of a specified percentage of the account value as of a specified date, and a specified percentage of a highest account value achieved as of a specified date following establishment of the annuity account (col. 7, lines 62-67 – col. 8, lines 1-57).

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Golden additionally discloses various payment methods including manipulation of the beneficiary payments such as: a method wherein upon death of the account owner, the account value, if any, is paid to the designated account beneficiary; a method wherein upon the death of the account owner, a specified percentage of the initial account value is paid to a designated account beneficiary; a method wherein upon the death of the account owner, a specified percentage of the account value, if any, as determined on a specified date following establishment of the annuity account, is paid to a designated account beneficiary; and a method wherein upon the death of the account owner, a specified percentage of the initial account value, less withdrawals, is paid to a designated account beneficiary (col. 7, lines 62-67 – col. 8, lines 1-57).

11. With regard to claim 21 and 22, Golden discloses a method wherein a guarantee provides for a return to the account owner of a specified percentage of the account value as of a specified date (col. 20, lines 35-44) and a step of inputting data related to at least one of the attained age and gender of the account owner (col. 7, lines 62-67 to col. 8, lines 1-3).

12. With regard to claims 23-25, Golden discloses manipulation of the withdrawal rates such as the methods of: a maximum amount of said withdrawals permitted under the guarantee for the given withdrawal frequency is determined by multiplying the maximum withdrawal rate and the account value as of a specified date; a maximum amount of said withdrawals permitted under the guarantee for the given withdrawal frequency is determined by multiplying said maximum withdrawal rate and the highest account value achieved as of a specified date following establishment of the annuity

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account; and redetermining a maximum amount of withdrawals permitted under the guarantee (col. 13, lines 9-24).

13. With regard to claims 30, 31, 32, 33, 34 and 36, Golden discloses contract/system terms such as: altering the terms of the guarantee if the withdrawal exceeds the maximum withdrawal rate; terminating the guarantee if the withdrawals exceed the maximum withdrawal rate; establishing a charge to pay for the guarantee; assessing a periodic fee for the guarantee and deducting such fee from the account value; adding an increment to an asset charge to pay for the guarantee (col. 13, lines 9-16) and having a withdrawal frequency that is per year (col. 3, lines 16-19).

14. With regard to claim 35, Golden discloses periodically redetermining the account value, absent additional deposits and excess withdrawals. It would be obvious to one skilled in the art that any appropriate formula for this calculation could be used (col. 19, lines 12-29).

### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached Monday - Friday 8:30 AM - 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jocelyn Greimel  
Examiner, AU 3624  
March 17, 2006



**HANI M. KAZIMI**  
**PRIMARY EXAMINER**